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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,273	02/01/2001	Frank M. Sexton	103	7225

7590 06/30/2006

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,273	Applicant(s) SEXTON ET AL.	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/1/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1, 3, 5-7, 9 and 12 have been examined in this application. This communication is the first action on the merits since the applicants filed a Request for Continuation (RCE) on May 22, 2006. No additional Information Disclosure Statements (IDS) have been filed in this case.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-7, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,752,236 to Sexton in view of "Auto-Homeowners packages look like a winner" by Thomas McCoy (hereinafter referred to as McCoy), US Patent Application Publication 2002/0072936 to Newman and in further view of US Patent Number 6,912,502 to Buddle.

(A) As per claims 1 and 5, As to claims 1 and 5, Sexton discloses a method for forming an insurance plan comprising the steps of:

collecting data concerning multiple insurance coverages (Sexton: Col. 9, lines 1-10 and col. 10, lines 10-21); (Note: The examiner takes the position that Sexton relates to prototype or tentative insurance contracts in that the insured in Sexton are inputting data in an attempt to

Art Unit: 3626

receive a quote of an estimated premium for a prospective (tentative) insurance policy (Sexton: Col. 4, Ln. 16-39).

inputting said data concerning multiple insurance coverages into a data processing apparatus (Sexton: Col. 13, lines 54-58);

collecting data about an individual or other risk to be insured (col.13, lines 62-66);

inputting said data individual related data or other risk into the data processing apparatus (col. 13, lines 62-66) ;

disproportionately allocating benefits and obligations regarding said prototype contract into at least two new proposed insurance contracts, said at least two new contracts being separate but related (Sexton: Col. 10, lines 35-40 and lines 51-66 and col. 12, lines 18-64); and

displaying all of the qualified (e.g. qualified under regulatory requirements) separate but related policies (Sexton: Col. 5, Ln. 43-48 and Col. 13, lines 39-42).

Sexton does not explicitly disclose selecting three or more coverages from said multiple insurance coverages to form a prototype policy, however, McCoy discloses selecting three or more coverages to form a prototype policy (i.e. package product)(abstract page 1 and page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by McCoy within Sexton for the motivation of providing increased retention (see abstract).

Sexton in view of McCoy do not teach that the insurance policy concerns three of more of the following categories: life, health, disability, major medical, critical illness, long-term care, and property and casualty; however, this feature is taught in Newman (Sections [0011]-[0012] and [0021—Sexton discloses three of these types of coverages from the aforementioned list]).

Art Unit: 3626

At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the combined method of Sexton in view of McCoy with the aforementioned feature from Newman with the motivation of providing insureds with a policy which provides various types of benefits including incidental expense benefits, supplemental benefits, and long term care benefits, as recited in Newman (Section [0009]).

Sexton in view of McCoy and Newman do not teach the step of testing the new proposed insurance contracts against regulatory requirements, however, this feature is taught by US Patent Number 6,912,502 to Buddle (Abstract and Claims). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Sexton in view of McCoy and Newman with the motivation of having a means to manage compliance issues, as recited in Buddle (Col. 1, Ln. 5-10; Field of the Invention).

(B) As per claims 3 and 7, Sexton discloses a method as claimed in claim 1 wherein the data about an individual to be insured includes information concerning one or more of the following subjects: sex, age, marital status, individual medical history, family medical history, usage of alcohol, tobacco and drugs, automobile driving record, credit report, financial statement, criminal record, current medical examination report and results and any physical disabilities and impairments (col. 13, lines 62-66).

(C) As per claim 6, Sexton discloses an insurance system as claimed in claim 5 wherein: base product data relates to the probability of the event insured against occurring, the time value of money, the benefits promised, expenses, and profits and contingencies (Col. 9, Ln. 1-10).

Art Unit: 3626

(D) As per claim 9, this claim is substantially similar to claim 3 and is therefore rejected on the same basis.

(E) As per claim 12, this claim is substantially similar to claim 1 and is therefore rejected in the same manner.

Response to Arguments

4. Applicant's arguments with respect to claims 1., 3, 5-7, 9 and 12 have been considered but are moot in view of the new grounds of rejection. The new grounds of rejection address all the arguments the applicants have made with respect to the previous rejections over these claims. Specifically, in response to applicant's argument that there is no "motivation" to combine McCoy with Sexton, except for the teachings of the application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

5. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Art Unit: 3626


Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,



Vivek Koppikar

6/2/2006



C. LUKE GELLIGAN
PATENT EXAMINER